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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TECHNOLOGY CENTER 3700

Group Art Unit: 3711
Examiner: William M. Pierce
Serial No. 09/017,959
Applicant: David A. Bernhardt
Filing Date: February 3, 1998
For: **BOWLING BALL FINGER GRIP**



TRANSMITTAL OF
APPEAL BRIEF

AND REQUEST
FOR ONE MONTH
EXTENSION OF TIME

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Enclosed herewith are the original and two copies of Appellant's Appeal Brief for the above-identified application.

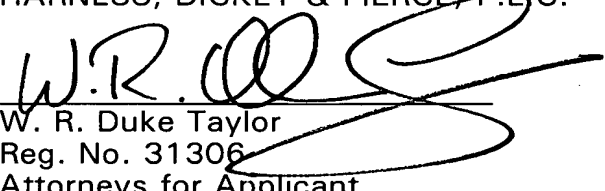
A check in the amount of \$205.00 is enclosed to cover the appeal brief filing fee as required by 37 C.F.R. §1.17(c) in the amount of \$150.00, plus the fee due for a one month extension of time in the amount of \$55.00. If for some reason Appellant has inadvertently paid an insufficient fee to prevent the abandonment of this application, please charge our Deposit Account No. 08-0750 for any further fees which may be due. A duplicate copy of this transmittal is enclosed.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.C.

Dated: June 3, 1999
P.O. Box 828
Bloomfield Hills, MI 48303
Telephone: (248) 641-1600

BY:


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Attorney Docket No. 8117-000021

WRDT/kmg

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on JUNE 3, 1999.

By 

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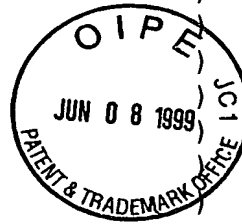
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By W. R. COO

Dear Sir:

This is an appeal from the December 4, 1998 final rejection of Claims 1-16 of the above-identified application. No claims have been allowed. No claims have been cancelled.

Claims 1-16 are rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-16 are also rejected under 35 U.S.C. Section 102(b) as being anticipated by Stevens. The claims on appeal are Claims 1-16 and are reproduced in Appendix A.

REAL PARTY IN INTEREST

David A. Bernhardt is the real party in interest.

* Fees on transmittal

RELATED APPEALS AND INTERFERENCES

To the best of Applicant's knowledge, no other appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the present pending appeal.

STATUS OF THE CLAIMS

Claims 1-16, which are all of the pending claims in this application, stand finally rejected.

STATUS OF AMENDMENTS

Applicant filed an Amendment After Final on March 3, 1999; however, no amendments were made to the claims.

SUMMARY OF THE INVENTION

The invention relates to a bowling ball accessory or finger grip (See Figures 1 and 2 (10)). The accessory or finger grip includes a tubular member (20) with a bore (22) to receive the finger of a bowler (See Figures 1 and 2). A gripping surface (24) is on the tubular member (20). A plurality of gripping members (42) are on the gripping surface (24) for contacting a bowling ball (See Figure 4). The gripping surface (24) is arcuate or curved and has gripping members (42) having a desired configuration such that when force is exerted by the bowler on the ball, the gripping members (42) flatten providing a larger surface area on the ball to enhance contact with the ball (See Figure 1). A copy of the patent application is attached hereto as Appendix B.

ISSUE

Appellant presents the following issue for review:

- 1) Whether or not Claims 1-16 are unpatentable under 35 U.S.C. §102(b) over Stevens.

GROUPING OF THE CLAIMS

Claims 1-5 stand or fall together. Claims 6-16 stand or fall together.

ARGUMENT

Background of the Invention

The present invention relates to bowling, and more particularly to a gripping device positioned on the bowler's index finger to enable the bowler to impart spin upon the bowling ball.

In bowling, while the ball is rolling down the lane, it is desirous to produce rotation about the horizontal axis of the ball. This rotation creates a hook in the ball as it is rolled down the lane. The hook action on the ball enables the ball to move laterally with respect to the pins so that the ball contacts more pins creating pin action to increase the number of pins knocked down.

In order to create hook on the bowling ball, the bowler contacts his index finger against the ball. In doing so, the bowler creates friction on his finger, which, in turn causes blisters or callouses to form on the bowler's index finger. Since both blisters and callouses are undesirable, bowlers search for aids to eliminate these ailments. Bowlers have used tape, bandages and the like to prohibit blisters or callouses. However, these surfaces become glazed and do not enable the bowler to exert the proper friction, in turn, rotation onto the ball to create the desired hook.

Thus, the present invention provides the art with such device. The present invention provides the art with a grip which protects against blisters and callouses

while providing a superior gripping action on the ball. The gripping surface of the present invention enables the bowler to achieve additional revolutions on the ball while it is rolling down the lane.

The Stevens reference fails to anticipate Applicant's invention or render it obvious to those skilled in the art. It is respectfully submitted that the Examiner is misapplying the reference and is utilizing hindsight to reconstruct Applicant's invention.

The Examiner has rejected Claims 1-16 under 35 U.S.C. Section 102(b) as being anticipated by Stevens (Des. 97,360). A copy of the Examiner's Final Rejection and a copy of the Stevens reference are attached to this Appeal Brief as Appendix C and D, respectively.

First, the Stevens reference is a design patent. The Stevens reference has no specification. Stevens illustrates four views of a finger toothbrush. The Stevens finger toothbrush fails to disclose or suggest a bowling ball accessory or bowling finger grip which is utilized by a bowler to exert hook onto a bowling ball.

The standard for nonanalogous art has long been established by the Court of Appeals for the Federal Circuit. The Court of Appeals for the Federal Circuit in In re Deminski, 230 USPQ 313 (Fed. Cir. 1986), citing In re Wood and Eversole, 202 USPQ 171 (CCPA 1979), states:

The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

In re Deminski, supra at 315.

Applying the first part of the test, if the reference is within the field of the endeavor, Applicant asserts that a toothbrush is not in the same field of endeavor as a bowling ball finger accessory or bowling ball finger grip. One skilled in

bowling accessories would not look to a toothbrush to impart hook onto a bowling ball.

The court has determined that:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" [cite omitted] - in other words, common sense - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In re Oetiker, 24 USPQ 2d (Fed. Cir. 1992) at 1445-1446.

It is clearly apparent that the Examiner has not applied common sense in applying the cited art. One looking for a solution in the bowling ball accessory art would not look to the toothbrush art. The invention is to provide spin onto the ball not to utilize a brush for cleaning it off.

The above also encompasses the second step, which is to determine whether the reference is reasonably pertinent to the particular problem which the inventor is involved. The problem the inventor is involved with is imparting spin onto a bowling ball. The brushing of one's teeth is not reasonably pertinent to the spinning of a bowling ball.

Accordingly, Applicant believes that the Examiner has misapplied the reference and that the Stevens reference is nonanalogous art.

Further, Applicant asserts that the Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. See In Re Fine, 5 USPQ 2d at 1600. Thus, just because the Examiner can analogize that the Stevens reference is similar to Applicant's invention, there is no motivation or suggestion in Stevens that it be used as a bowling ball accessory or finger grip as claimed by Applicant.

Claims 1-5 and 6-16 stand and fall together. Accordingly, Applicant believes the above groupings to be proper.

With respect to the Examiner's Section 112 rejection, Applicant believes the claims to be proper within the meaning of Section 112. The Examiner has not stated any specifics as to why Applicant's claim are allegedly indefinite other than making a conclusive statement. Accordingly, Applicant believes the claims are in proper order and overcome the Examiner's Section 112 rejection.

CONCLUSION

Applicant respectfully submits that the Examiner has found nonanalogous art which neither discloses nor suggest Applicant's invention. Thus, Applicant believes that one skilled in the art would not consider the Stevens reference in the inventor's field of endeavor nor would consider it reasonably pertinent to the particular problem which Applicant is involved.

Applicant's invention provides the art with a bowling ball accessory or finger grip that is neither suggested nor disclosed by the prior art. Accordingly, reversal of the final rejection of Claims 1-16 and allowance of the claims is respectfully requested.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

Dated: June 3, 1999

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